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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,261	10/04/2000	Bruce L. Davis	60303	7123

23735 7590 06/28/2002

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

ALEXANDER REINDOR, NAA OBOSHIE C

ART UNIT PAPER NUMBER

2671

DATE MAILED: 06/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,261

Applicant(s)

DAVIS ET AL.

Examiner

Naa-Oboshie Alexander-Reindorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the present invention including all claimed limitations must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

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REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).
"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37
CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A
"Sequence Listing" is required on paper if the application discloses a
nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if
the required "Sequence Listing" is not submitted as an electronic
document on compact disc).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing
subject matter which was not described in the specification in such a way as to enable
one skilled in the art to which it pertains, or with which it is most nearly connected, to
make and/or use the invention.

a. As per claims 1-4, applicant refers to circuitry coupled to the sensor that
produces multi-bit information. Applicant also refers to a transfer means—either
a cable or wireless link, for relaying the output data. But applicant does not
provide support in the disclosure for these elements. Page 1 of the specification

mentions "processing circuitry....[that] tracks movement of patterns across the sensor's field of view". Then page 3 mentions "wireless links...freeing the user from the constraint imposed by the cable". The disclosure does not provide sufficient support for these elements because there is no enablement detailing how these elements are implemented or perform the functions respectively claimed.

b. As per claim 5, applicant refers to a decoder for discerning steganographically-encoded information. But applicant does not provide support in the disclosure for this element. Page 4 of the specification mentions "The Bedoop detection system... decodes same to extract the steganographically-embedded data hidden therein." The disclosure does not provide sufficient support for the decoder because there is no enablement detailing how it is implemented and performs the functions claimed.

c. As per claims 6 and 7, applicant refers to an optical sensor comprising an array of sensor elements. Page 1 of the specification mentions "the optical sensing system can comprise a 1D...or a 2D array". The disclosure does not provide sufficient support for these elements because there is no enablement detailing how these elements are implemented or perform the functions respectively claimed.

d. As per claim 9, applicant refers to optically encoded information that comprises a plural-bit identifier. But applicant does not provide support in the disclosure for this element. Page 2 of the specification mentions "Bedoop data

... optionally with data identifying the consumer.” The disclosure does not provide sufficient support for this identifier because there is no enablement detailing how it is implemented.

e. As per claim 10, applicant refers to processing optical sensor data. But applicant does not provide support in the disclosure for this step. Page 2 of the specification mentions, “optical data collected by the sensor can be processed”. The disclosure does not provide sufficient support for this processing step because there is no enablement detailing how it is implemented.

f. As per claim 11, applicant refers to performing a steganographic decoding process. But applicant does not provide support in the disclosure for this element. Page 4 of the specification mentions “The Bedoop detection system... decodes same to extract the steganographicly-embedded data hidden therein.” The disclosure does not provide sufficient support for the steganographic decoding process because there is no enablement detailing how it is implemented and performs the functions claimed.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Rhoads (#6311214 B1) teaches the Bedoop technology.
- b. Lyon (#4521773) teaches an imaging array comprised of sensor cells.

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- c. Faulkerson (#4804949) and Knee et al. (#5994710) teach hand held peripheral scanning devices.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Naa-Oboshie Alexander-Reindorf** whose telephone number is **703-305-3897**. The examiner can normally be reached on Mondays-Thursdays from 8:30 – 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached at 703-305-4709.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to:

(703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

NAR
June 17, 2002



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600